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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,440

02/10/2004

Keiji Ogawa

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11/16/2005

MURATA MANUFACTURING COMPANY, LTD.

C/O KEATING & BENNETT, LLP

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SUITE 850

MCLEAN, VA 22102

EXAMINER

NGO, HUNG V

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,440

Applicant(s)

OGAWA ET AL

Examiner

Hung V. Ngo

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-23 is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, lines 11, 12, "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" is not discussed in the specification. Any negative limitation or exclusionary proviso must have basis in the original disclosure See Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983)(MPEP 2173.05(i)).

Claim 11, lines 10, 11, "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" is not discussed in the specification. Any negative limitation or exclusionary proviso must have basis in the original disclosure See Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983)(MPEP 2173.05(i)).

Claims 2-10, 12-19 are included because of their dependencies.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 13, 14, 16, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida et al (US 6,079,099).

Uchida discloses an integrated electronic component comprising
a ceramic substrate 20 including circuit elements (22,27) and external electrodes disposed on side surfaces (Fig 1)

a metal case (10) having a top segment and substrate-facing segments and being mounted on the ceramic substrate;

wherein bottom edges of the substrate-facing segments oppose a top surface of the ceramic substrate, the substrate-facing segments have notches at positions opposing corners of the top surface of the ceramic substrate, and the notches have a tapered shape having a circular arc shape as shown in Fig 1 (re claim 11)

Regarding claim 13, the circuit elements (22) are disposed within the ceramic substrate.

Regarding claim 14, the circuit elements (27) are mounted on the ceramic substrate.

Regarding claim 16, the ceramic substrate 20 includes a plurality of laminated ceramic sheets as shown in Fig. 2.

Regarding claim 17, the metal case 10 has a substantially box-like shape as shown in Fig. 1.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (US 6,079,099).

Regarding claim 15, Uchida et al. does not disclose that the metal case is of at least one of phosphor bronze and nickel silver.

Examiner takes Official Notice that phosphor bronze and nickel silver are well known in the shielding art for their conductive properties. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the phosphor bronze and nickel silver material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin 125 USPQ 416.

Regarding claims 18 and 19, Uchida et al. does not show the claimed ranges of component dimensions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the claimed range of component dimensions, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

Applicant's arguments with respect to claim 11 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 1-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 20-23 are allowed

The following is an examiner's statement of reasons for allowance:

The limitation "the notches have a tapered shape having obtuse angles with respect to the bottom edges of the substrate-facing segments" of claim 1, "a portion of a top edge of each of the substrate-facing segments is spaced from a bottom surface of the top segment" of claims 20, 21, "the metal case includes side segments, the substrate-facing segments are seamlessly connected to the side segments at positions opposing the corners of the top surface of the ceramic substrate, such that the substrate-facing segments are supported at borders with the side segments in a cantilevered fashion" of claims 12, 22, 23 in combination with other limitations present is neither taught nor disclosed in the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung V. Ngo whose telephone number is (571) 272-1979. The examiner can normally be reached on Monday to Thursday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-2800 EXT 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HVN
11-13-05

Hung V. Ngo

**HUNG V. NGO
PRIMARY EXAMINER**